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EXAMINER

LUONG, VINH

ART UNIT

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3656

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,634	Applicant(s) VILLA ET AL.	
	Examiner Vinh T. Luong	Art Unit 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/21/2005</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Appendix</u> . |

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1. The preliminary amendment filed on September 30, 2005 has been entered.
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of the implied phrase "The present invention . . ." Correction is required. See MPEP § 608.01(b).

4. The drawings are objected to because of the reasons, *e.g.*, listed below:

(a) The drawings are not in compliance with 37 CFR 1.84. Please see Form PTO-948 attached;

(b) The reference numerals, such as, 1 and 20 lack a lead line and/or a free standing arrow. Please see 37 CFR 1.84(q) and (r);

(c) Each part of the invention, such as, *e.g.*, the latching elements of the shaft 70 in claim 6, the bearing bushings or bearing halves in claim 10 should be designated by a reference character or numeral. Please see MPEP § 608.01(o); and

(d) The drawings must not use the same reference character to indicate different things or *vice versa*. Please see 37 CFR 1.84(p)(4). For example, the same reference character 28 is used to indicate different things in FIGS. 2 and 5.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing

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sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features, such as, e.g., the latching elements of the shaft 70 in claim 6 and the bearing bushings or bearing halves in claim 10 must be shown or the features canceled from the claims. No new matter should be entered.

6. The disclosure is objected to because of the informalities, e.g., listed below:

(a) Each part of the invention, such as, e.g., the latching elements of the shaft 70 in claim 6 (Spec. ¶ 30) and the bearing bushings or bearing halves in claim 10 should be designated by a reference character or numeral. Please see MPEP § 608.01(o); and

(b) The specification must not use the same reference character to indicate different things or *vice versa*. Please see 37 CFR 1.84(p)(4). For example, the same reference character 28 is used to indicate different things (Spec. pp. 6 and 9).

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Appropriate correction is required.

7. Claim 11 is objected to because of the following informalities: the claim has typographical error. For example, the term “ripped” should have been changed to “ribbed.”

Appropriate correction is required.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 6 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain(s) subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant claims, *inter alia*, the latching elements of the shaft 70 in claim 6, and the bearing bushings or bearing halves in claim 10. However, Applicant's drawings do not show the instant claimed features. It is unclear how Applicant made/used the latching elements and the bearing bushings or bearing halves as claimed.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 6, 8-10, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear which structures define the claimed elements, such as, the latching elements of the shaft 70 in claim 6, and the bearing bushings or bearing halves in claim 10. See MPEP § 608.01(o). Applicant is respectfully suggested to identify each claimed element with reference to the drawings.

Claim 6 recites the limitation "it" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The term "technical" in claim 8 is a relative term which renders the claim indefinite. The term "technical" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear, e.g., what objective standard(s) is(are) required in order to determine whether a particular plastic material is "a technical plastic material."

The terms, such as, "*can be mounted*" in claim 6 and "*can be actuated*" in claim 15 are vague and indefinite in the sense that things which may be done are not required to be done. For example, in claim 15, the electrical switch can be actuated, but is not required structurally to be actuated by the parking brake lever. See "crimpable" in *In re Collier*, 158 USPQ 266 (CCPA 1968), "discardable" in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), "removable" in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and "comparable" in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 1-3, 5, and 11-14, and claims 6, 8-10, and 15, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer (EP 1127760 A2) in view of Burgstaler (US 2003/0140726 A1).

Claim 1

Bauer teaches a parking brake lever unit for the use in a motor vehicle comprising:

a parking brake lever 8 of a plastic material (*id.*, abstract);

a support 3, 7 at which the parking brake lever 8 is pivotably supported;

a locking unit comprising a pawl 5 mounted at the parking brake lever 8, and a ratchet insert 6.

In summary, Bauer teaches the invention substantially as claimed except the plastic material for the support 3, 7 and the over-molded metal for the ratchet insert 6.

Burgstaler teaches the plastic for making the support 1-3 and the over-molded metal for making the insert 8-11 in order to, *inter alia*, reduce the weight of the parking brake lever unit. Burgstaler, ¶ 5.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plastic for making Bauer's support and over-molded metal for making Bauer's ratchet insert in order to reduce the weight of Bauer's parking brake lever unit as taught or suggested by Burgstaler.

The modification of Bauer's parking brake lever unit by selecting the materials as taught or suggested by Burgstaler would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement" *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) and it "does no more than yield predictable results." *KSR* at 1739. As noted, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); MPEP 2144.07; and *Ritchie v. Vast Resources Inc. d/b/a Topco Sales*, Fed. Cir., No. 2008-1528, 4/24/09. In addition, the determination of patentability is based on the product itself, not by its method of production (over-molding). *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985); *SmithKline Beecham Corp. v. Apotex Corp.*, 78 USPQ2d 1097 (Fed. Cir. 2006); and MPEP § 2113.

Claim 2

Bauer's ratchet insert 6 comprises locking teeth (unnumbered in FIG. 1) and wherein the ratchet insert 6 is integrated into the support 3, 7 so that substantially only the locking teeth are exposed.

Claim 3

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Bauer's ratchet insert 6 comprises mounting holes (see Appendix hereinafter "App."), which are capable of being filled with plastic material during injection molding of the support 3, 7. In addition, the determination of patentability is based on the product itself, not by its method of production (injection molding). *In re Thorpe; SmithKline Beecham Corp. v. Apotex Corp.*; and MPEP § 2113 *supra*.

Claim 5

Bauer's parking brake lever 8 is pivotally supported by means of a shaft 15 within the support 3, 7.

Burgstaler teaches the parking brake lever 6 being pivotally supported by means of a shaft 31 within the support 1-3, wherein the shaft 31 comprises a plastic material in order to reduce the weight of the unit. Burgstaler, ¶ 25.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form Bauer's shaft of plastic material in order to reduce the weight of the Bauer's unit as taught or suggested by Burgstaler.

Claim 6

Bauer's shaft 15 is a self-locking shaft, which comprises integrated latching elements 14, 16, 16a (FIG. 2), so that it can be mounted within the support 3, 7 without additional mounting elements.

Claim 8

Burgstaler teaches the technical plastic material polyamide, *i.e.*, Applicant's material. In addition, Burgstaler used an additive TPE. Burgstaler, ¶ 30. Therefore, Burgstaler's plastic material inherently comprises self lubricating characteristics.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a technical plastic which comprises self-lubricating characteristics for making Bauer's lever, support, and shaft in order to reduce the weight of Bauer's parking brake lever as taught or suggested by Burgstaler. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR, supra*.

Claim 9

Burgstaler's plastic material comprises additives, such as, TPE for achieving self-lubricating characteristics. Burgstaler, ¶ 30.

Claim 10

Bauer teaches the bearing bushing or bearing halves 14 (FIG. 1).

Burgstaler teaches the bearing bushing or bearing halves 31 of a metal or plastic material. Burgstaler, ¶ 25. In addition, Burgstaler teaches the technical plastic material comprising self-lubricating characteristics. Burgstaler, ¶ 30.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the plastic that comprises self-lubricating characteristics for making the bearing bushing or bearing halves in order to reduce the weight of the parking brake lever unit of Bauer as taught or suggested by Burgstaler. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR, supra*.

Claim 11

Burgstaler's support 1-3 comprises a stiff plate 27, which is ribbed at its underside (FIGS. 2 and 3).

Claim 12

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Burgstaler's support 1-3 comprises an essentially plane plate 3 (FIG. 1). Similarly, Bauer's support 3, 7 comprises an essentially plane plate (App.).

Claim 13

Burgstaler teaches metallic mounting inserts 8-11 in order to improve the deformation in case of an accident. Burgstaler, abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the metallic mounting inserts in the plane plate of the support of the unit of Bauer and Burgstaler in order to improve the deformation in case of an accident as taught or suggested by Burgstaler. *KSR, supra*.

Claim 14

Bauer's support 3, 7 comprises an integrated latching element (App.) for the mounting of the parking brake lever unit at the vehicle. Similarly, Burgstaler's support 1-3 comprises an integrated latching element 3 (FIG. 4) for the mounting of the parking brake lever unit at the vehicle.

Claim 15

Burgstaler teaches an electrical switch, which can be actuated by the parking brake lever in order to detect the position of the pedal. Burgstaler, ¶ 14.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the electrical switch in the support of the unit of Bauer in order to detect the position of the pedal as taught or suggested by Burgstaler. *KSR, supra*.

15. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Burgstaler as applied to claim 1 above, and further in view of Noel et al. (JP 7-190109 A).

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Claim 4

Bauer and Burgstaler teach the invention substantially as claimed except the metal or plastic pawl.

Noel teaches the plastic pawl 17 in order to reduce noise. Noel, English abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select plastic for making Bauer's pawl in the lever unit of Bauer as modified by Burgstaler in order to reduce noise as taught or suggested by Noel. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR, supra*.

16. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Burgstaler as applied to claim 1 above, and further in view of Ruf et al. (EP 0933270 A1 cited by Applicant).

Bauer's parking brake lever 8 comprises a grip 11 at its grip area.

Bauer and Burgstaler teach the invention substantially as claimed except the plastic material for the grip.

Ruf teaches the plastic material for the grip 2 in order to reduce weight. Ruf, abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select plastic for making Bauer's grip in order to reduce the weight of the parking brake lever unit of Bauer and Burgstler'726 as taught or suggested by Ruf. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR, supra*.

17. Claims 8-10, as best understood, are further rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Burgstaler as applied to claim 1 above, and further in view of Yokochi et al. (US 7,051,616).

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Assuming *arguendo* that Burgstaler's plastic material does not inherently comprise self-lubricating characteristics, the following rejection takes place.

Claim 8

Bauer and Burgstaler teach the invention substantially as claimed except the technical plastic material which comprises self-lubricating characteristics for making the Bauer's lever, support, and shaft.

Yokochi teaches the technical plastic material comprising self-lubricating characteristics. Yokochi, c. 4, l. 62 *et seq.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a technical plastic which comprises self-lubricating characteristics for making Bauer's lever, support, and shaft in order to reduce the weight of Bauer's parking brake lever as modified by Burgstaler so that no additional lubricants or special bearings or bearing halves must be used as taught or suggested by Yokochi. *Sinclair & Carroll Co. v. Interchemical Corp* and *KSR, supra*.

Claim 9

Yokochi's plastic material comprises additives, such as, PTFE for achieving self-lubricating characteristics. Yokochi, c. 4, l. 62 *et seq.*

Claim 10

Burgstaler teaches the bearing bushing or bearing halves 31 of a metal or plastic material. Burgstaler, ¶ 25.

In summary, Bauer and Burgstaler teach the invention as claimed except the self-lubricating characteristics.

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Yokochi teaches the technical plastic material comprising self-lubricating characteristics.

Yokochi, c. 4, l. 62 *et seq.*

It would have been obvious to one having ordinary skill in the art at the time the invention was made to select the plastic that comprises self-lubricating characteristics for making the bearing bushing or bearing halves in order to reduce the weight of the parking brake lever unit of Bauer and Burgstaler'726 as taught or suggested by Yokochi. *Sinclair & Carroll Co. v. Interchemical Corp.* and *KSR, supra*.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Krupin (metal insert pawl 18, see ¶ 14), La Rosa (grip 4 and ribs 3), and Prat (polyamide, see ¶ 42).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vinh T Luong/
Primary Examiner, Art Unit 3656